

This Opinion is Not a
Precedent of the TTAB

Mailed: March 30, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Headspace Meditation Limited
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Serial No. 79281613
—

Hannah L. Cannom of WSC LLP,
for Headspace Meditation Limited.

Lyal Fox, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Bergsman, Shaw and English,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Headspace Meditation Limited (“Applicant”) seeks registration on the Principal Register of the mark SLEEPCAST, in standard characters, for goods and services identified as:

Audio recordings featuring fictional stories; Audio recordings featuring fictional stories to be used for purposes of meditation, relaxation and sleep-induction; Pre-recorded downloadable audio recordings featuring fictional stories; Downloadable musical recordings; Downloadable computer software featuring narrative fictional stories for purposes of meditation, relaxation and somnolence and sleep-induction; Downloadable podcasts in

the field of fictional stories; Headphones; Wireless headphones; Audio speakers; Wireless speakers; Virtual reality headsets, in International Class 9;

Entertainment services, namely, providing non-downloadable prerecorded music and non-downloadable audio recordings featuring fictional stories via a global computer network; Audio entertainment services, namely, providing non-downloadable prerecorded music and non-downloadable audio recordings featuring fictional stories via a global computer network; Teaching in the field of meditation, relaxation and somnolence and sleep-induction practices, in International Class 41; and

Meditation, relaxation and somnolence and sleep-induction services being alternative medicine services offered exclusively online; Provision of online meditation, relaxation and somnolence and sleep-induction services in the nature of alternative medicine services; Provision of meditation, relaxation and somnolence and sleep-induction services in the nature of meditation and relaxation therapy services offered online by means of a mobile phone application, in International Class 44.¹

The Examining Attorney refused registration of Applicant's mark as to classes 9 and 41 under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the identified goods and services.

In addition, the Examining Attorney refused registration of Applicant's mark as to class 44 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the

¹ Application Serial No. 79281613, filed on December 12, 2019 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), with a priority date of June 12, 2019, based on International Registration No. 1521459.

ground of likelihood of confusion with the mark CAST,² in standard characters, for “Behavioral health services in the nature of mental health and addiction treatment services; Clinical mental health counseling services; Counseling in the field of mental health and wellness; Mental health services; Multi-disciplinary, integrative, outpatient health care delivery and medical consultations; Rehabilitation of alcohol addicted patients,” in International Class 44.

When the refusals were made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. The case is fully briefed. We affirm the refusals to register.

I. Mere Descriptiveness

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, . . . when used on or in connection with the goods [or services] of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). A term is “merely descriptive” within the meaning of Section 2(e)(1) “if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). A term “need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513

² Registration No. 5049386, issued September 27, 2016.

(TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)).

“Descriptiveness must be evaluated ‘in relation to the particular goods or services for which registration is sought, the context in which the mark is used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use,’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *Bayer*, 82 USPQ2d at 1831), and “not in the abstract or on the basis of guesswork.” *Fat Boys Water Sports*, 118 USPQ2d at 1513 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). “In other words, we evaluate whether someone who knows what the goods [or services] are will understand the mark to convey information about them.” *Id.* at 1515 (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)).

The Examining Attorney argues that “both the individual components [of Applicant’s mark] and the composite result are descriptive of applicant’s goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services.”³ According to the Examining Attorney:

[T]he term SLEEP means “a natural periodic state of rest for the mind and body,” and the term CAST is a common abbreviation for PODCAST which is defined as “a series of digital media files distributed over the internet to which a user can subscribe by means of a syndication application.” . . . Moreover, the identification of goods and services explicitly states that the applicant’s digital media files are

³ Examining Attorney’s Br., 8 TTABVUE 19.

for “for purposes of . . . sleep-induction.” Therefore, the term SLEEPCAST is merely descriptive of the goods and services provided by the applicant in Classes 009 and 041, namely, that the applicant provides downloadable and non-downloadable digital media files, including podcasts, which are for the purpose of inducing consumers into a natural periodic state of rest for the mind and body.⁴

To support the refusal, the Examining Attorney introduced the following fourteen Internet webpage excerpts showing that podcasts are used to promote improved sleep:⁵

1. Casper.com, listing “15 Sleep Podcasts That Will Help You Doze Off Easier.”
2. Discoverpods.com, describing “10 Relaxation and Sleep Podcasts So Effective, I Nearly Feel Asleep Writing this List.”
3. Blog.castbox.fm, identifying the “Best Podcasts for Sleep or Relaxing at Night.”
4. Tuck.com, listing “The Best Podcasts for Sleep.”
5. Thegoodtrade.com, advising on “5 Sleep Podcast For A Better Bedtime Routine.”
6. Healthline.com, identifying “7 Podcasts for Sleep, Relaxation, and Sleep Science.”

⁴ *Id.* at 8 TTABVUE 19-20. *See* The American Heritage Dictionary definitions for “sleep” and “podcast” attached to the March 31, 2020 Office Action, TSDR 5, 17.

⁵ March 31, 2020 Office Action, TSDR 24-26; February 17, 2021 Office Action, TSDR 36-46.

7. Greatist.com, featuring an article entitled “Can’t Get to Sleep? Plug Into One of These Podcasts,” and identifying the “Best sleep podcasts.”
8. Bostonglobe.com, listing “Eight podcasts that could help you get some sleep.”
9. Wellandgood.com, identifying “5 Bedtime Story Podcasts That Just Might Be the Secret to Better Sleep in Stressful Times.”
10. Bustle.com, referring to the podcast “Sleep With Me” as “the master of the sleep podcasts.”
11. Arubahclinic.com, referring to the podcast “Meditation Oasis” as “The Meditation Oasis sleep podcast,” and referring to the podcast “Sleep With Me” as “one of the best-reviewed sleep podcasts out there.”
12. Podchaser.com, featuring the “Top Rated Sleep Podcasts.”
13. Theglitterguide.com, referencing “10 Podcasts To Help You Sleep.”
14. Sleep.ihg.com, advising on “The 5 best sleep podcasts.”

We find that the foregoing websites excerpts establish that podcasts are used to help consumers more easily get to sleep, or to sleep better. Further, these types of podcasts are sometimes called “sleep podcasts.”

The Examining Attorney also introduced Internet website excerpts to show that the term CAST is a common abbreviation or shorthand for the term PODCAST. The following fourteen website excerpts are most relevant:⁶

⁶ March 31, 2020 Office Action, TSDR 18-23; February 17, 2021 Office Action, TSDR 25-35.

1. Statesmen.com, stating that the Play Music mobile application “could now access podcasts,” allowing users “to catch ‘Serial,’ ‘The TED Radio Hour’ and other popular ‘casts.”
2. The Extra Podcast, stating that memberships include “access to a website with all past popular casts.”
3. Musicbusinessworldwide.com, identifying Gimlet Media as a company “behind popular ‘casts”
4. Emilyannhart.com, identifying “tried and true podcasts (all available via iTunes) to get started for a newbie and some less popular casts for those looking for something new.”
5. Cnet.com, discussing the Apple Podcast mobile application which allows users to “explore popular ‘casts,” and is distinct from the Apple Music mobile application “which didn’t let [users] subscribe to new ‘casts on [their] mobile.”
6. Fluentu.com, listing “The Top 15 Language Podcasts for Curious Multilingual Minds,” and advising that “These are the top casts about language learning and linguistics.”
7. Askmen.com, identifying “Best Podcasts for Career Inspiration,” and stating readers can “Take [Their] Career to the Next Level With These Top ‘Casts.”
8. Pressplaygaming.net, listing “PPG Gaming Podcast Picks” and stating “here are 5 top casts well worth listing to.”

9. Podparadise.com, discussing a Metagamers Anonymous podcast in which a reviewer identifies the podcast as “One of the top casts on my play list.”
10. Auxavclub.com, advertising their podcast coverage on Podmass featuring a “weekly roundup of the best ’casts out there.”
11. Podcasts.apple.com, featuring “The Buzz @ StreetIQ” podcast stating “The Buzz @ StreetIQ will offer weekly casts on activities surrounding StreetIQ. You will get cast reviews, previews, industry news, how to find the best casts, information for business Podcasts and more.”
12. Classpass.com, listing “10 Fitness Podcasts to Download Today,” and advising that this new list updates a post from 2018 “that featured the best casts for health and wellness professionals.”
13. Facebook, featuring a post by the History of Pirates Podcast in which they call the podcast “Rumor Flies” “[o]ne of the best casts out there!”
14. Up.audio, featuring the podcast “FurCast” in which a reviewer states “it is one of the best casts I’ve listened to.”

We find that the foregoing website excerpts establish that the term “cast” is used as an abbreviation or shorthand for the term “podcast.” That is, potential consumers will understand CAST to describe downloadable and non-downloadable digital media files, such as those identified in Applicant’s goods and services.

When we consider Applicant’s mark as a whole, we agree with the Examining Attorney that SLEEPCAST is merely descriptive of Applicant’s goods and services and does not create a unique, incongruous, or non-descriptive meaning in relation to

the goods and services. The terms SLEEP and CAST retain their descriptive meaning in relation to the goods and services, and the combination results in a composite mark that is itself descriptive and not registrable. *Fat Boys Water Sports*, 118 USPQ2d at 1516 (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)). SLEEPCAST is simply a shortened form of “sleep podcast.” Consumers, upon encountering the SLEEPCAST mark used in connection with Applicant’s goods and services for “sleep-induction” would likely understand the mark to describe podcasts featuring recordings to induce or improve sleep.

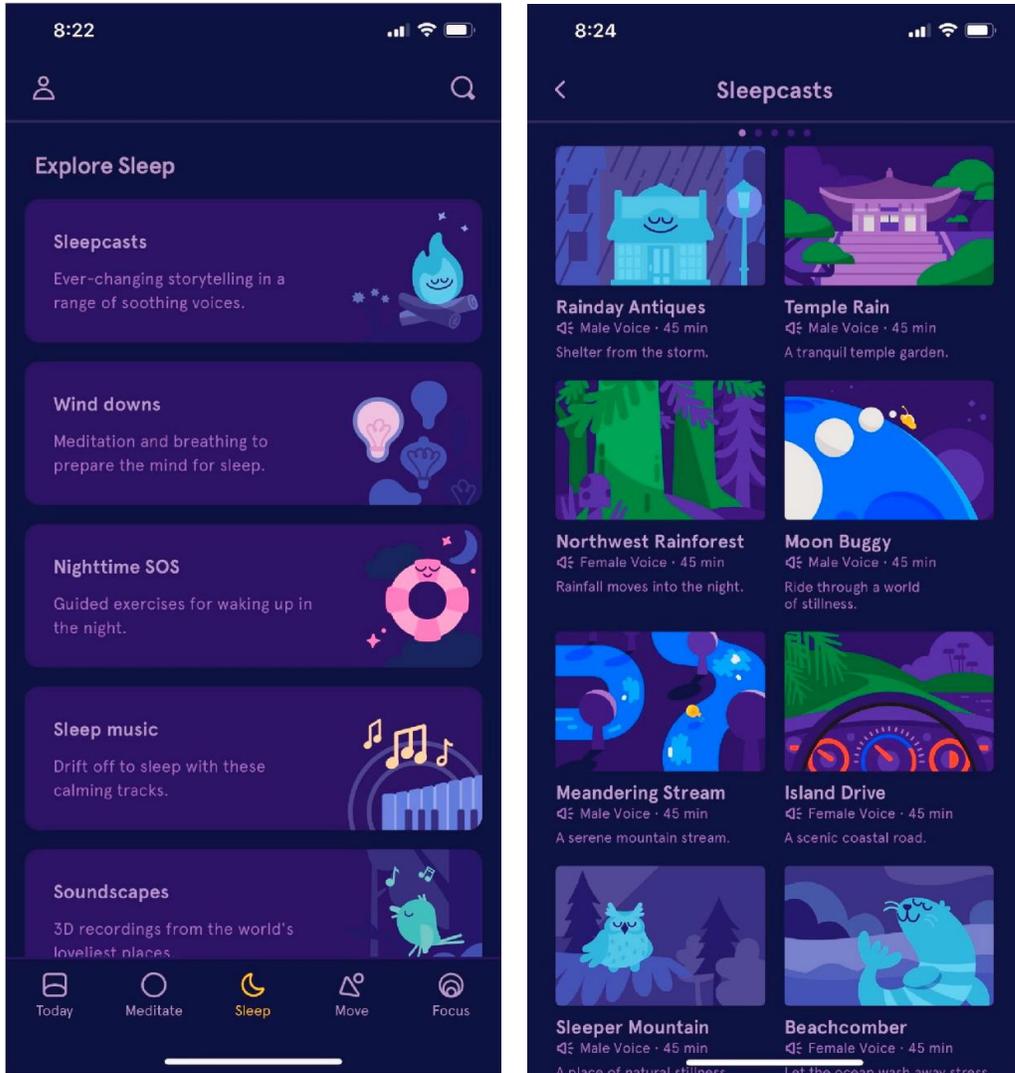
Applicant’s exhibits purportedly showing its use of the SLEEPCAST mark (reproduced below) further support this finding.⁷ These exhibits are described as screenshots of the Headspace App “showing use of the Applied-for Mark”⁸ and “showing the various goods and services offered under the Applied-for Mark.”⁹ The screenshots show “Sleepcasts”¹⁰ used as a sub-heading for a variety of recordings under the heading, “Explore Sleep.” Applicant’s “Sleepcasts” are described as “Ever-changing storytelling in a range of soothing voices.” Notably, “Sleepcasts” is used in the same manner as other arguably descriptive wording used to name recordings such as “Sleep music” and “Soundscapes.”

⁷ Exs. C and D to declaration of Hannah L. Cannom, October 20, 2020 response, TSDR 9-10, 23-26.

⁸ Cannom Dec., ¶ 4, October 20, 2020 response, TSDR 9.

⁹ *Id.* at ¶ 5.

¹⁰ Inasmuch as the exhibits are not specimens of use, we need not address whether Applicant’s use of the mark matches the drawing of the mark. *See* 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a)–(b).



Applicant argues that SLEEPCAST is not merely descriptive because “[t]he SLEEPCAST mark does not describe the recordings offered under the mark with any degree of particularity[.]”¹¹ Applicant points out that the Examining Attorney’s sleep podcast evidence includes genres such as bedtime stories, meditation, sleep science, relaxing sounds, hypnosis, and Bible stories. According to Applicant:

[U]nder the broad umbrella of sleep podcasts, there are many different genres, each with its own qualities and

¹¹ Applicant’s Br., p. 21, 6 TTABVUE 22.

characteristics. . . . Accordingly, a consumer who understands that the services offered under the SLEEPCAST mark are digital media files for relaxation and inducing sleep cannot immediately grasp what particular kind of recordings are being offered.¹²

This argument is unpersuasive. The fact that the “the broad umbrella of sleep podcasts” includes a variety of different genres does not mean that SLEEPCAST is not merely descriptive when used in connection with podcasts that do, in fact, focus on aiding or enhancing sleep. Here, it is sufficient for a finding of mere descriptiveness that Applicant’s SLEEPCAST goods and services comprise products for the purpose of “sleep-induction.” “[A] mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or services] for which registration is sought.’” *Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). With respect to each class in the application, “if the mark is descriptive of some identified items – or even just one – the whole class of goods [or services] still may be refused by the” Examining Attorney. *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1171 (TTAB 2013) (citing *Chamber of Commerce*, 102 USPQ2d at 1220).

Applicant also argues that “[t]he cases cited in the Final Office Action do not support the conclusion that SLEEPCAST is merely descriptive of the purpose of the services offered.”¹³ Specifically, Applicant takes issue with two of the cases cited by

¹² *Id.* at 21-22, 6 TTABVUE 22-23.

¹³ *Id.* at 23, 6 TTABVUE 24.

the Examining Attorney, *Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) and *Gyulay*, 3 USPQ2d 1009. Applicant argues that neither of these cases lists the “purpose” of the goods or services as being part of the test for mere descriptiveness under Section 2(e)(1).

This argument is unpersuasive as well. Although Applicant is correct that these two cases do not refer to the “function” of the goods when discussing the test for mere descriptiveness, the third case cited by the Examining Attorney, *Abcor*, 200 USPQ 215, includes the “purpose” of the goods as part of the test. In *Abcor*, the court stated: “we agree with the board that the term GASBADGE immediately and unequivocally describes the purpose and function of appellant’s goods.” *Id.* at 200 USPQ 219.

Moreover, it is well settled that the “purpose” of the goods may be part of the formulation for determining whether a mark is merely descriptive. *See DuoProSS Meditech*, 103 USPQ2d at 1755 (“[A] mark is merely descriptive if it ‘conveys information regarding a function, or purpose, or use of the goods.’”) (quoting *Abcor*, 200 USPQ at 217); *Stereotaxis*, 77 USPQ2d at 1089 (affirming the Board’s finding that STEREOTAXIS was merely descriptive of medical devices and services because it described their “nature, purpose or function”). *See also, In re Realistic Co.*, 440 F.2d 1393, 169 USPQ 610, 610 (CCPA 1971) (“[A] mark is descriptive if it describes the purpose for which the goods are to be used.”); *In re W. A. Sheaffer Pen Co.*, 158 F.2d 390, 72 USPQ 129, 129 (CCPA 1946) (“The commissioner properly held that ‘it is now well settled that a mark is descriptive within the meaning of the Act if it describes the intended purpose, function, or use, of the goods to which it is applied.’”).

Applicant further argues that the USPTO has registered three CAST-formative marks on the Principal Register without a claim of acquired distinctiveness under Section 2(f), which shows that such marks are suggestive, not merely descriptive.

Applicant points to:

POTCAST, Reg. No. 6167746, for entertainment and educational services, namely, providing podcasts in the fields of cannabis, entrepreneurship, business management, personal development, public policy, government relations, public advocacy, and business strategy consulting, in class 41;

THE CABINCAST, Reg. No. 6129790, for entertainment services, namely, providing podcasts in the field of Cabin, Mountain, Lakehome, and Vacation home living and lifestyle, in class 41; and

CRIMECAST, Reg. No. 6070520, for podcasts in the field of investigative journalism, true crimes, solved crimes, unsolved crimes, crimes, mysteries, investigations, investigative news, crime and justice, in classes 9 and 41.¹⁴

These three third-party registrations suggest that CAST-formative marks may be registrable. *RxD Media, LLC v. Application Dev. LLC*, 125 USPQ2d 1801, 1812 (TTAB 2018) (“[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade, industry, or ordinary parlance.”) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)).

¹⁴ Ex. F. to Cannom Dec., October 20, 2020 response, TSDR 36-39.

However, the fact that some third-party registrations exist for marks allegedly similar to Applicant's proposed mark is not conclusive on the issue of descriptiveness. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“[P]rior registrations do not conclusively rebut the Board’s finding that ULTIMATE is descriptive in the context of this mark.”); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977). Here, the record amply demonstrates that the term “sleep podcast” is commonly used in the industry to refer to recordings for inducing sleep. This suggests that SLEEPCAST may be more descriptive than the CAST-formative marks shown above. Moreover, unlike *Juice Generation*, in which extensive evidence of third-party registration and use of similar marks was found to be “powerful on its face” 115 USPQ2d at 1674, Applicant has presented only three examples of third-party use of CAST-formative marks. This is far less evidence than that found persuasive in *Juice Generation*.

In any event, each case must stand on its own merits, and a mark that is merely descriptive must not be registered on the Principal Register simply because other such marks appear on the register. *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“[T]he proper time for measuring inherent distinctiveness is at the time of registration.”). Here, the record supports the finding that SLEEPCAST is merely descriptive when used in connection with prerecorded

music and non-downloadable audio recordings featuring fictional stories, all used for sleep-induction.

II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). As noted above, Registration has been refused under Section 2(d) of the Trademark Act only as to Applicant’s services in class 44, namely:

Meditation, relaxation and somnolence and sleep-induction services being alternative medicine services offered exclusively online; Provision of online meditation, relaxation and somnolence and sleep-induction services in the nature of alternative medicine services; Provision of meditation, relaxation and somnolence and sleep-induction services in the nature of meditation and relaxation therapy services offered online by means of a mobile phone application.

The refusal is based on a registration for the standard character mark CAST for:

Behavioral health services in the nature of mental health and addiction treatment services; Clinical mental health counseling services;

Counseling in the field of mental health and wellness; Mental health services; Multi-disciplinary, integrative, outpatient health care delivery and medical consultations; Rehabilitation of alcohol addicted patients

A. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression

We begin with the *DuPont* factor relating to the similarity of the marks. In comparing the marks in their entireties, we must consider their appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity as to any one of these elements may be sufficient to support a finding that the marks are confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019). *See also Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Although marks must be considered in their entireties, it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the similarity of the marks. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on

consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”).

Applicant’s mark is SLEEPCAST, in standard characters, and Registrant’s mark is simply CAST, also in standard characters. Applicant’s mark encompasses the entirety of Registrant’s mark, adding only the term SLEEP before CAST. While there is no rule that confusion is automatically likely where one mark encompasses another, in this case, as in many others, the fact that Registrant’s entire mark is incorporated within Applicant’s mark increases the similarity between the two. *See, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (affirming Board’s finding that applicant’s mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties’ marks); *Coca-Cola Bottling Co. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL is similar to BENGAL LANCER); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (finding applicant’s mark VANTAGE TITAN confusingly similar to registered mark TITAN); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (finding applicant’s CAREER IMAGE marks similar to registered mark CREST CAREER IMAGES).

The Examining Attorney’s dictionary and Internet evidence establishes that SLEEP is merely descriptive when used in connection with Applicant’s “somnolence and sleep-induction services.” Although CAST can be an abbreviation or shorthand for “podcast” when used in connection with recordings as discussed above, the

Examining Attorney notes that “evidence from American Heritage dictionary establishes that the term CAST has many meanings, and when used within the context of the medical services provided by both the registrant and applicant, could be perceived by consumers as giving the same meaning and commercial impression in both marks.”¹⁵

Although the word SLEEP is the leading term in Applicant’s mark, we find it is not the dominant term in Applicant’s mark because it modifies CAST—suggesting that the services involve sleep. Instead, we find CAST to be the dominant portion of Applicant’s mark. CAST also is the dominant portion of Registrant’s mark inasmuch as it forms the entirety of the mark. When we consider the marks in their entirety, we find that both Applicant’s SLEEPCAST mark and Registrant’s CAST mark have a similar connotation and commercial impression—albeit with Applicant’s mark having a more specific “sleep” connotation.

Applicant argues that “SLEEP should be given more weight than CAST, and when considered as a whole, the two marks are different and confusion unlikely.”¹⁶ We acknowledge that the presence of the term SLEEP as the leading term in Applicant’s mark differentiates it visually and aurally from the registered mark. This point of distinction, however, does not significantly diminish the strong similarities in connotation and overall commercial impression engendered by these two marks. We find that SLEEPCAST is more similar to the mark CAST than dissimilar,

¹⁵ Examining Attorney’s Br., 8 TTABVUE 7.

¹⁶ Applicant’s Br., p. 13, 6 TTABVUE 14.

particularly in terms of connotation and commercial impression. As a result, consumers encountering SLEEPCAST and CAST could mistakenly believe the former is a variation on the registered mark, used to identify a sleep-related line of alternative medicine services. *See Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *7 (TTAB 2019) (“Here, ROAD WARRIOR looks, sounds, and conveys the impression of being a line extension of WARRIOR.”); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.”).

Applicant argues, based on Registrant’s location in Southern California, that CAST alone has a different connotation or commercial impression as compared to its SLEEPCAST mark: “[i]n the context of the Registrant’s Hollywood theme, CAST suggest[s] a selected team of professionals, each with a role to perform, working together to help clients with mental health or addiction concerns.”¹⁷ We must consider the meaning and connotation of the registered mark in the context of Registrant’s identification of services, which does not include any geographic restriction, so it is unclear whether Registrant’s mark would convey the commercial impression Applicant describes. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017) (“The Board properly analyzed likelihood of confusion based on

¹⁷ *Id.* at 14, 6 TTABVUE 15.

the mark as applied to the goods recited in Symbolic’s application compared to registrants’ marks and the goods recited in their registrations.”); *In re Embiid*, 2021 USPQ2d 577, at *17-18. But even if true, we see no reason why CAST in Applicant’s SLEEPCAST mark could not have a similar connotation.

Applicant also argues that the registration of the three third-party CAST-formative marks discussed above, suggests that the term CAST is weak. We disagree that the third-party marks are probative; they are used in connection with services that are dissimilar to Applicant’s and Registrant’s alternative medicine and mental health services. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (the controlling inquiry is the extent of third-party marks in use on “similar” services). In addition, as noted above, Applicant has presented only three examples of third-party use of CAST-formative marks. This is far less evidence than that found persuasive in *Juice Generation*.

The *DuPont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

B. Similarity or dissimilarity of the services

We next turn to the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. We compare the services as they are identified in the involved application and cited registration. *See Stone Lion*, 110 USPQ2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Likelihood of confusion must be found as to the entire class if there

is likely to be confusion with respect to any service that comes within the recitation of services in that class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

As noted above, Applicant's services in class 44 are:

Meditation, relaxation and somnolence and sleep-induction services being alternative medicine services offered exclusively online; Provision of online meditation, relaxation and somnolence and sleep-induction services in the nature of alternative medicine services; Provision of meditation, relaxation and somnolence and sleep-induction services in the nature of meditation and relaxation therapy services offered online by means of a mobile phone application.

Registrant's services in class 44 are: "Behavioral health services in the nature of mental health and addiction treatment services; Clinical mental health counseling services; Counseling in the field of mental health and wellness; Mental health services; Multi-disciplinary, integrative, outpatient health care delivery and medical consultations; Rehabilitation of alcohol addicted patients."

The Examining Attorney argues that the respective services are related because: "the same entity commonly offers both meditation and/or relaxation therapy services, and offers behavioral health, mental health, and/or addiction treatment services and markets these services under the same mark."¹⁸ To establish that the respective services are related, the Examining Attorney introduced the following thirteen

¹⁸ Examining Attorney's Br., 8 TTABVUE 9.

Internet webpage excerpts showing that alcohol and drug treatment programs also provide meditation therapy services:¹⁹

1. The Villa Treatment Center, offering alcohol and drug treatment, and providing meditation therapy services.
2. Silvermist, offering addiction treatment and alternative meditation therapy services.
3. Promises Behavioral Health, offering behavioral health services, addiction treatment services, mental health services, and meditation services.
4. Renewal Lodge by Burning Tree, offering substance abuse treatment services, mental health services, and meditation services.
5. The Hope House, offering addiction treatment services, and mindfulness and meditation services.
6. Integrative Life Center, offering addiction and mental health therapy services, and meditation therapy services.
7. Pillars Recovery, offering addiction treatment services and meditation therapy services.
8. New Method Wellness, offering substance abuse treatment services, mental health services, and meditation therapy services.
9. Red Oak Recovery, offering addiction treatment services, and meditation therapy services.

¹⁹ March 31, 2020 Office Action, TSDR 6-12; February 17, 2021 Office Action, TSDR 2-24.

10. Kemah Palms, offering addiction treatment services, and meditation therapy services.
11. Restore Health & Wellness Center, offering drug addiction treatment services and meditation therapy services.
12. WestWind, offering substance abuse treatment services and meditation therapy services.
13. First Step Center, offering substance abuse treatment services and meditation therapy services.

The foregoing evidence establishes that mental health and addiction treatment programs often offer meditation therapy as part of their mental health treatment services. Thus, consumers familiar with Registrant's mental health and addiction treatment services could assume that Applicant's online alternative medicine services featuring meditation, relaxation, and somnolence and sleep-induction were related. This is particularly so given that a number of health and addiction treatment programs include strategies for maintaining wellness after treatment, including meditation. For example, the Pillars Recovery program website states: "Not only will [meditation] help you achieve sobriety, but you can also use it after your release to resist temptation and avoid a relapse."²⁰ The Red Oak Recovery website states that patients who meditate "gain familiarity to the point [they] feel comfortable practicing meditation on [their] own or joining a group after treatment. . . . People who meditate

²⁰ Pillarsrecovery.com, February 17, 2021 Office Action, TSDR 10.

suffer fewer relapses and more benefits than those not engaging in this focused practice.”²¹

Applicant argues that its services differ from those of the Registrant: “[t]he services offered under the Applied-for Mark are distinct from residential and outpatient treatment for mental health and addiction. Indeed, Applicant offers meditation and sleep-related services under the Applied-for Mark exclusively through its meditation and mindfulness mobile phone app, Headspace.”²²

This argument is unpersuasive. The services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). In other words, the issue is not whether the services will be confused with each other, but rather whether the public will be confused as to their source. *Id.* (“[E]ven if the goods [or services] in question are different from, and thus not related to, one another in kind, the same goods [or services] can be related in the mind of the consuming public as to the origin of the goods [or services].”). *See also Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [they] emanate from the same source.” (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *In re Ox*

²¹ Redoakrecovery.com, February 17, 2021 Office Action, TSDR 16.

²² Applicant’s Br., p. 16. 6 TTABVUE 17.

Paperboard, LLC, 2020 USPQ2d 10878, at *5 (TTAB 2020); *L’Oreal v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012). Given the use of meditation as an alternative form of treatment by mental health and addiction programs, including self-treatment after discharge, we find it likely that consumers would think that the respective services were related.

The *DuPont* factor relating to the similarity of the services favors a finding of likelihood of confusion.

C. Established, likely-to-continue channels of trade and classes of consumers.

Under the third *DuPont* factor, concerning “[t]he similarity or dissimilarity of established, likely-to-continue trade channels,” *Stone Lion*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567), we must base our determination regarding the similarities or dissimilarities between channels of trade and classes of purchasers for the services as they are identified in the application and the cited registration. *Octocom*, 16 USPQ2d at 1787; *Mini Melts v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1471 (TTAB 2016).

Applicant’s alternative medicine services featuring meditation, relaxation, and somnolence and sleep-induction are offered online. Registrant’s identified mental health and addiction treatment services, which include “outpatient health care delivery and medical consultations,” do not include any restrictions or limitations as to trade channels. We therefore must presume Registrant’s services are or would be offered in all normal trade channels for such services, including online. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167,

1173 (Fed. Cir. 2013); *Thor Tech*, 90 USPQ2d at 1638 (“We have no authority to read any restrictions or limitations into the registrant’s description of goods [or services].”); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

Applicant argues that the channels of trade are different because its services are directed to individuals interested in using applications on their phones for meditation, mindfulness, relaxation and healthier sleep”²³ whereas “Registrant’s website clearly describes its services as treatments for substance abuse and mental health conditions.”²⁴ But Registrant’s identification of services is not limited to “substance abuse and mental health conditions” as Applicant argues. Rather, it includes “counseling in the field of mental health and wellness” as well as “outpatient health care delivery and medical consultations.” These services are more closely related to Applicant’s “alternative medicine services” and could be offered online. Moreover, determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use such as Registrant’s website. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *i.am.symbolic*, 123 USPQ2d at 1749).

The *DuPont* factor relating to the channels of trade and classes of consumers favor a finding of likelihood of confusion.

²³ *Id.* at 18, 6 TTABVUE 19.

²⁴ *Id.*

D. Absence of actual confusion

Based on the declaration of Applicant's Director of Legal Affairs, Michael Marchand, Applicant argues that it has been using its SLEEPCAST mark since September 18, 2018, and is "not aware of any consumer confusion between the Applied-for Mark and the Cited Mark."²⁵ In the absence of evidence regarding the extent to which Applicant and Registrant have used their marks for the respective services, Applicant's claim of no actual confusion is entitled to little weight. For example, we do not know where or to whom Applicant or Registrant have sold their services. Thus, we cannot gauge whether or the extent to which there has been a meaningful opportunity for confusion to occur. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF's use of the VITTORIO RICCI mark on the merchandise in question in prior years[.]"); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

This *DuPont* factor is neutral.

²⁵ *Id.* at 19, 6 TTABVUE 20. *See* Ex. F to Cannon Dec., October 20, 2020 response, TSDR 40.

E. Conclusion

Because the respective services are related, travel in the same trade channels to the same classes of consumers, and the marks are similar, there is a likelihood of confusion between Applicant's mark, SLEEPCAST, for the recited services in class 44, and the cited mark, CAST.

Decision: The refusals to register Applicant's mark SLEEPCAST under Sections 2(d) and 2(e)(1) of the Trademark Act are affirmed.